REMARKS

In the restriction requirement mailed September 11, 2007, the Examiner requested restriction under 35 U.S.C.§121 and 372 to one of the following Groups:

Group I. Claims 1-6 and 27-32 drawn to the use of an anti-resorptive compound for a disease modifying effect on an arthritic condition;

Group II. Claim 7-11 drawn to the use of an anti-resorptive compound for a disease modifying effect on subchondral bone sclerosis;

Group III. Claims 12-16, drawn to the use of an anti-resorptive compound for preventing osteophyte formation or progression in a mammal;

Group IV. Claims 17-21, drawn to the use of an anti-resorptive compound for preventing joint deterioration in a mammal;

Group V. Claims 22-26, drawn to the use of an anti-resorptive compound for inhibiting vascular invasion in calcified cartilage in a mammal; and

Group VI. Claim33, drawn to the use of an anti-resorptive compound with an androgen receptor modulator, an osteoclast proton ATPase inhibitor, and HMG-CoA inhibitor, an osteoblast anabolic agent, calsitonin, Vitamin K2 or its salts, or mixtures thereof for a disease modifying effect.

In each of the six Groups, the Examiner has required i) an election of a species or invention to be examined even though the requirement can be traversed (37 CFR 10143) and (ii) identification of the claims encompassing the elected invention (Office Action mailed September 11, 2007, page 4).

Applicants respectfully traverse the restriction requirement. However, to be fully responsive to the restriction requirement, Applicants, elect, with traverse, the subject matter of Group I, Claims 1-6 and 27-32 drawn to the use of an anti-resorptive compound for a disease modifying effect on an arthritic condition. Claims 1 and 27 are the claims encompassed within Group I.

The Examiner alleges that the technical feature linking the inventions of Groups I through VI lack novelty and does not constitute as special technical feature as defined by PCT Rule 13.2 and does not define a contribution over the prior art. A reference, Whiteford et al. (WO 94/14455), was cited by the Examiner to teach the use of a composition comprising two anti-resorptive compounds, estrogen and bisphosphonates,

for the many conditions including osteoarthritis Paget's disease, osteoporosis, and age-related bone disease. See Office Action, page 2.

Applicants further submit that the Examiner has failed to meet the burden necessary to impose a restriction requirement. There are two criteria for a proper requirement for restriction between patentably distinct inventions:

(1) The inventions must be independent (see MPEP §§ 802.01, 808.1) or distinct as claimed (see MPEP §§ 806.05-806.05(i)); **and**

(2) There must be a serious burden on the Examiner if restriction is not required (see MPEP §§ 803.02, 806.04 (a) – (j)), 808.01(a) and 808.02).

In the instant invention, the Examiner has not shown that there would be a serious burden to examine Groups I through IV together. The claims of Groups I-V include an anti-resorptive compound. Applicants respectfully submit that a search of the subject matters of Groups I through IV, in addition to the subject matter of Group VI, would not be burdensome because a proper search of the subject matter of Groups I through IV would necessarily encompass the search of the subject matter of Group VI since all claims include an anti-resorptive compound.

Applicants respectfully request that the restriction requirement be reconsidered and withdrawn or modified in view of the foregoing comments.

If a telephonic communication with the Applicants' representative will advance the prosecution of the instant application, please telephone the representative indicated below. Applicants believe no additional fees are due but the Commissioner is authorized to charge any fees required in connection with this response to Merck Deposit Account No. 13-2755.

Respectfully submitted,

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